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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,297	07/09/1999	YOSHINORI SHIBATA	99143	7865

7590 03/24/2003

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EXAMINER

RACHUBA, MAURINA T

ART UNIT PAPER NUMBER

3723

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary

Application No.

09/350,297

Applicant(s)

SHIBATA ET AL.

Examiner

M Rachuba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/24/01, 12/12/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-59 is/are pending in the application.
- 4a) Of the above claim(s) 26,30,39,45 and 53 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 55-59 is/are allowed.
- 6) ☒ Claim(s) 17-25,27-29,31-38,40-44,46-52 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Suspension of Action

1. The suspension of action, mailed October 2, 2002, is hereby lifted. A non-final action on the merits is set forth below.

Election/Restrictions

2. Applicant has successfully argued against the restriction of claims 55-59. Those claims are now rejoined, and have been examined on their merits as set forth below. The pending claims under consideration are claims 17-25, 27-29, 31-38, 40-44, 46-52, and 54-59. Claims 26, 30, 39, 45 and 53 are withdrawn from consideration as being directed to a non-elected species.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims s 17-25, 27, 28, 41-44, and 47-52 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Judge, 6,523,447. Note especially figure 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 29, 46 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judge '447 in view of Walker et al, 6,004,689. '447 do not disclose the structural details of the battery case, such as openings to allow passage of debris. '689, figure 3, teaches the use of openings **84, 86** in a battery case to allow ventilation, and inherently the removal of debris. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided '447 with a battery case having openings, for ventilation and removal of debris, as taught by '689, figure 3.

8. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judge, '447. '447 does not disclose the details of the driving connection between the motor and saw blade. The examiner takes Official notice that one of ordinary skill would recognize that a belt drive is one of several old and well known drive options between

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the motor and saw blade, and would have found it obvious to have provided '447 with a belt between the motor and saw blade to drive the blade.

9. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judge '447. "447 discloses the claimed invention except for the location of the battery and motor substantially aligned in the same plane as the saw blade. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have placed the battery and motor as claimed, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. In this case, applicant does not gain any unexpected result from positioning the battery and motor as claimed, as '447, in placing the battery and motor beside the saw blade, still balances the saw blade when it is in its utmost vertical position.

Allowable Subject Matter

10. Claims 55-59 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not disclose or fairly teach mounting the battery and battery case on an auxiliary table connected to the table of the saw apparatus.

Conclusion

12. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to M. Rachuba whose telephone number is (703) 308-1361. The examiner can normally be reached on Monday through Friday from 8:30 AM to 4:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not

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acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail, can be reached on (703) 308-2687. The fax phone number for this Group is (703) 872-9302.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. RACHUBA
PRIMARY PATENT EXAMINER
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mtr
March 18, 2003